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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,606	06/08/2001	Min Lu	19603/2921 (CRF-D-2484A)	1604

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EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

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DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/877,606

Applicant(s)

LU ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-91 is/are pending in the application.
- 4a) Of the above claim(s) 62-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Office Action

Status of the Claims

1. Applicants' election with traverse of Group I (claims 48-61) in paper no. 18 is acknowledged. The traversal is based upon the argument that the inventions of Groups I-VI constitute one invention and are not independent. Applicants further maintain that it would not be a serious burden on the examiner if restriction is not required. The regulations governing restriction requirements are set forth in 37 C.F.R. §§ 1.141 and 1.142. Establishment of *prima facie* evidence for a serious burden requires the demonstration, by appropriate explanation, of either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. § 808.02. The following items adduce a *prima facie* showing of burden: 1) The inventions of Groups I-VI display both separate classifications and a separate status in the art as set forth in paper no. 17. 2) The inventions of Groups I-VI are directed towards independent and distinct inventions as clearly set forth in paragraphs 4-8 of the last Office action. Accordingly, each invention will generate unique issues regarding novelty, patentability, and enablement. 3) Since the inventions disclosed *supra* are directed towards patentably distinct material, a search for one invention would not necessarily result in the identification of art that is concomitant with that required to address the issues generated by the other inventions. Applicants' arguments have been thoroughly considered but are not deemed persuasive for the reasons set forth *supra* and in the original restriction requirement (paper no. 17). **The requirement is still deemed to be proper and is therefore made FINAL.** Claims 62-91 are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

2. The information disclosure statements filed 31 December, 2001, and 28 October, 2002, have been placed in the application file and the information referred to therein has been considered.

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35 U.S.C. § 112, Second Paragraph

3. Claims 48-61 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite for failing to set forth the salient characteristics of the each monomer and how the interact to form a trimer. Applicants should clearly and unambiguously provide the structural details of each monomer and the relationship of these monomers to the final trimeric structure.

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35 U.S.C. § 112, First Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 48-61 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In *re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). In *re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976).

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To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient

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detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. The issue raised in this application is whether the original application provides adequate support for the broadly claimed genus of monomeric peptides. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997). The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the biomolecule of interest. *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993). *In re Deuel*, 51 F.3d 1552, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995). A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1995). The court noted in this decision that a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not reasonably lead those skilled in the art to any particular species.

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. For some biomolecules, examples of identifying characteristics include a nucleotide or amino acid sequence, chemical structure, binding affinity, binding specificity, and molecular weight. The written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function. Without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. In the latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written description requirement. *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404, 1406 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). *In re Wilder*, 736 F.2d 1516, 1521, 222 U.S.P.Q. 369, 372-3 (Fed. Cir. 1984). Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

The claims of the instant application are directed toward a

stabilized viral envelope protein comprising a trimer composed of monomers. The only structural limitation placed upon the End monomers is that they contain the core sequence AA-AA-AA-AA-AA-AA-AA wherein the first position can contain Leu, Ile, Val, or Ser, the second position Trp, the third position Asn, Ser, Thr, or Asp, the fourth position Trp, the fifth position Phe, Leu, Tyr, or Ser, the sixth position Asp, Ser, Asn, Gly, Thr, or Glu, and the seventh position I.e. or Met. Thus, the claims encompass a large and complex genus of proteins. However, the disclosure only describes the preparation of a single trimer consisting of chimeric HIV-1 gp41 monomers fused to the GCN4-pII domain. The disclosure fails to provide any guidance pertaining to acceptable amino acid substitutions. The disclosure fails describe any other suitable molecules. Thus, the skilled artisan would reasonably conclude that applicants were in possession of a GCN4-pII-gp41 fusion protein at the time of filing. However, the skilled artisan would also reasonably conclude that applicants were not in possession of any other fusion peptides. Thus, the disclosure fails to provide an adequate written description for the claimed invention.

Correspondence

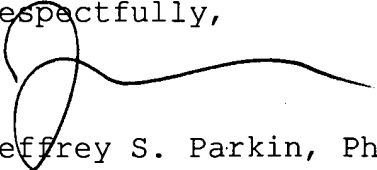
6. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate their expeditious processing and entry.

7. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227. The examiner can normally be reached Monday through Thursday from 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be

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Applicants: Lu, M., and H. Ji.

reached at (703) 308-4027 or (703) 308-1122, respectively. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,



Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

03 May, 2003